

United States Court of Appeals
for the
District of Columbia Circuit



**TRANSCRIPT OF
RECORD**

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Court of Appeals, District of Columbia

JANUARY TERM, 1903.

No. 1272.

199

No. 12, SPECIAL CALENDAR.

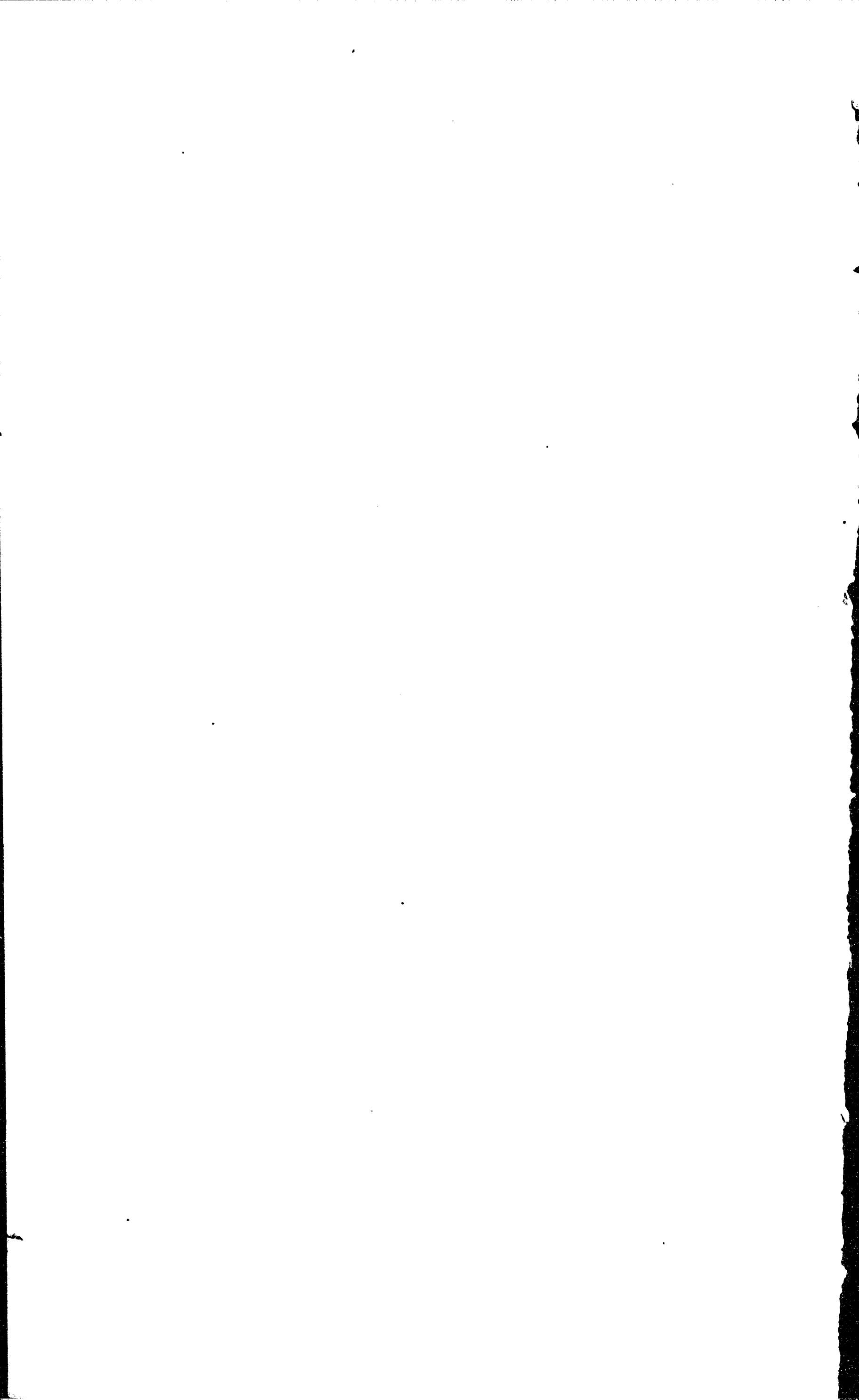
UNITED STATES *EX RELATIONE* CHARLES P. STEINMETZ, APPELLANT,

v.s.

FREDERICK I. ALLEN, COMMISSIONER OF PATENTS.

APPEAL FROM THE SUPREME COURT OF THE DISTRICT OF COLUMBIA.

FILED JANUARY 13, 1903.



COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

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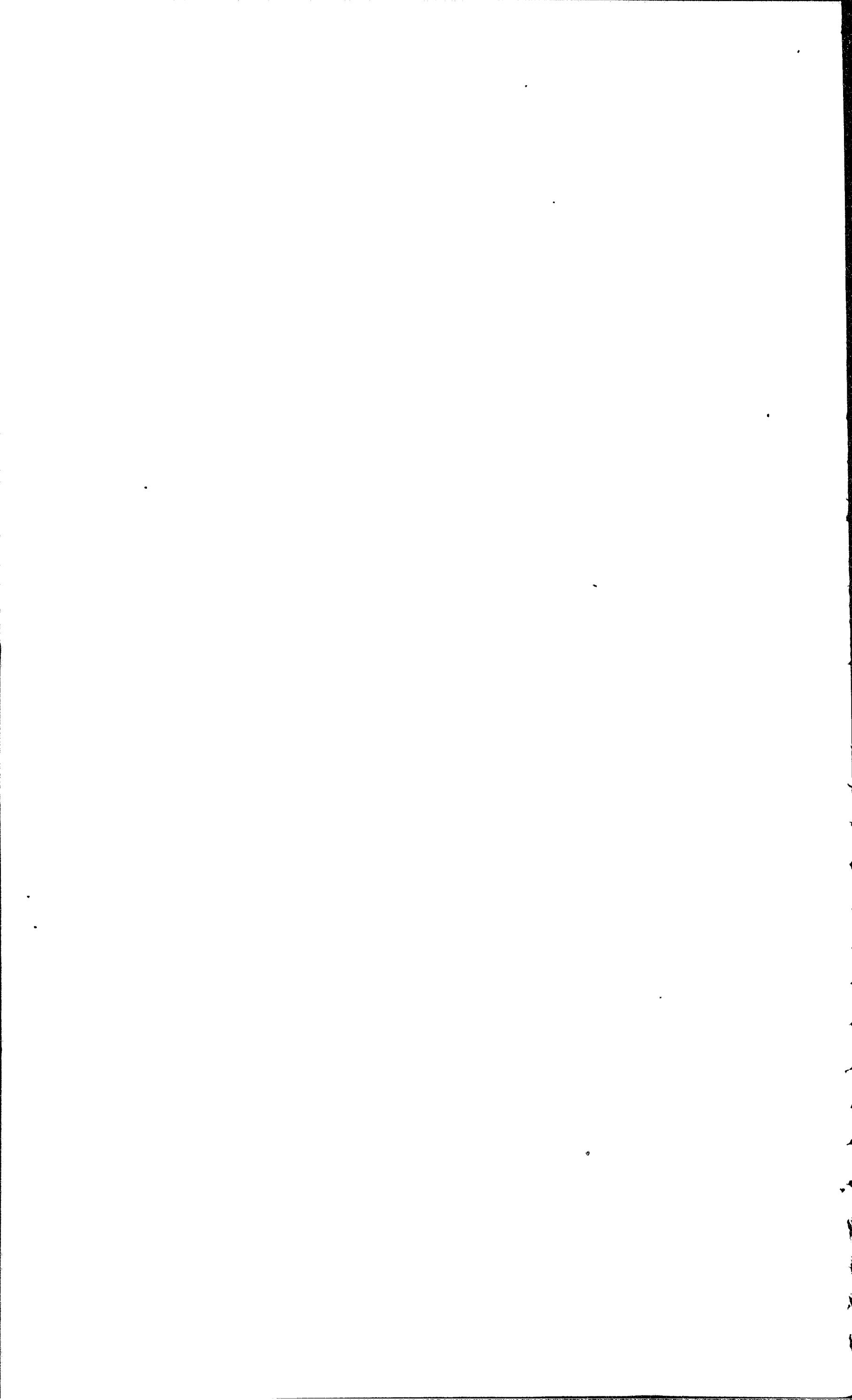
vs.

FREDERICK I. ALLEN, COMMISSIONER OF PATENTS.

APPEAL FROM THE SUPREME COURT OF THE DISTRICT OF COLUMBIA.

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In the Court of Appeals of the District of Columbia.

UNITED STATES *ex Rel.* CHARLES P. STEINMETZ, }
Appellant,
vs.
FREDERICK I. ALLEN, Commissioner of Patents. } No. 1272.

a Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* CHARLES P. STEIN- }
metz, Petitioner,
vs.
FREDERICK I. ALLEN, Commissioner of Pat- } No. 45620. At Law.
ents, Respondent.

UNITED STATES OF AMERICA, }
District of Columbia, } ss:

Be it remembered, that in the supreme court of the District of Columbia, at the city of Washington, in said District, at the times hereinafter mentioned, the following papers were filed and proceedings had, in the above-entitled cause, to wit:—

1 *Petition for Mandamus.*

Filed September 9, 1902.

In the Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* CHARLES P. STEIN- }
metz
vs.
FREDERICK I. ALLEN, Commissioner of Pat- } At Law. No. 45620.
ents.

To the supreme court of the District of Columbia :

Your petitioner, Charles P. Steinmetz, respectfully represents :
1. That he is a citizen of the United States and resides at Schenectady, in the county of Schenectady, and State of New York ;
2. That prior to the 21st day of November, 1896, he was the true, original and first inventor and discoverer of certain new and useful improvements in motor meters, not known or used by others in this country and not patented or described in any printed publication

2 UNITED STATES EX RELATIONE CHARLES P. STEINMETZ VS.

in this or any foreign country before his invention or discovery thereof, and not in public use or on sale in this country for more than two years prior to his hereinafter-mentioned application for letters patent therefor; and so being the true, original and first inventor thereof, he, on the said 21st day of November, 1896, filed in the United States Patent Office an application for letters patent of the United States for said invention.

2 3. That said application was made, by your petitioner, in writing, and addressed to the Commissioner of Patents, in due form, as required by the statutes of the United States, and by the rules of practice in the United States Patent Office in such case made and provided and with said application was filed by your petitioner a written description of his said invention, and of the manner and process of making, constructing, practicing and using the same, in such full, clear, concise and exact terms as to enable any person skilled in the art or science to which said invention appertains or with which it is most closely connected, to make, construct, practice and use the same; and in such written description the principle of your petitioner's said invention and the best mode in which your petitioner contemplated applying the same were explained; and your petitioner particularly pointed out and distinctly claimed in his said application the parts, improvements, combinations and methods which he claimed as his invention; and the specification and claims of said application were signed by your petitioner and attested by two witnesses;

4. That your petitioner did further furnish with said application drawings of his said invention, signed by his attorney and attested by two witnesses;

5. That your petitioner did further make oath before a proper officer, according to law, that he verily believed himself to be the original and first and sole inventor and discoverer of the said invention for which he solicited a patent, that he did not know and did not believe that the same was ever known or used, and did state of what country he was a citizen;

3 6. That your petitioner at the time of the filing of his said application did pay to the said Commissioner of Patents \$15, the fee required by law and did in all other respects fully comply with the statutes of the United States and with the rules of practice in the United States Patent Office in such cases made and provided and that the said application became known and designated as application serial No. 612,943.

7. That said application contained and contains the following claims of invention to which your petitioner believes himself entitled, viz:

1. The herein-described method of measuring alternating electric currents, which consists in setting up or establishing a shifting field of magnetism from three intersecting lines or axes of magnetization and adapted to actuate a rotatable armature in a motor meter arranged within the energizing coils producing said lines of magnetization.

2. The herein-described method of actuating an alternating-current motor meter, which consists in setting up or establishing a shifting field of magnetism from three intersecting lines or axes of magnetization and adapted to actuate a rotatable armature arranged within the energizing coils producing said lines of magnetization.

3. The herein-described method of actuating a single-phase alternating-current motor meter, which consists in setting up or establishing a shifting field of magnetism from three intersecting lines or axes of magnetization and adapted to actuate a rotatable armature arranged within the energizing coils producing said lines of magnetization.

4 4. The herein-described method of actuating an alternating-current motor meter, which consists in setting up or establishing a shifting field of magnetism by means of magneto-motive forces acting along three intersecting lines and subjecting an armature to the inductive action of said field.

5. The herein described method of actuating an alternating-current motor meter which consists in setting up or establishing a shifting field of magnetism by means of magneto-motive forces acting along three intersecting lines, one magneto-motive force being proportional to the current and the other two to the electro-motive force, and subjecting an armature to the inductive action of said field.

6. The herein-described method of actuating an alternating-current motor meter which consists in setting up or establishing a shifting field of magnetism by means of magneto-motive forces acting along three intersecting lines, one magneto-motive force being proportional to the current and the other two to the electro-motive force, the several magneto-motive forces being so proportioned and related to each other than the resultant of the last two is displaced in phase from the first by the complement of the angle of lag, and subjecting an armature to the inductive action of said field.

7. In a watt meter for alternating electric currents, means for producing a magnetic flux proportional to the current and varying in phase therewith, means for producing a second magnetic flux proportional to the electro-motive force and lagging in phase behind the same, and means for producing an auxiliary flux along a line at an angle to said second flux and of such magnitude and phase that the resultant of the two last-mentioned fluxes will lag behind the first by the complement of the angle of lag.

5 8. The combination in an electric motor of a field-magnet system and means for inducing therein magnetic fluxes of three phases, one a flux due to a series coil and proportional to the current, a second flux due to a shunt potential coil and lagging behind the electro-motive force and a third flux lagging behind said second flux and having a fixed angular relation thereto such that the resultant of the second and third fluxes is dephased by substantially the complement of the angle of lag from the flux due to the series coil.

9. The combination in a recording electric meter of a field-magnet system acting on the armature and having a plurality of intersecting magnetic axes, means for inducing along one of said mag-

4 UNITED STATES EX RELATIONE CHARLES P. STEINMETZ VS.

netic axes a flux proportional to the current and varying in phase therewith, and means for inducing along the other magnetic axes a plurality of other fluxes dependent upon the potential of the metered circuit, which lag behind the electro-motive force by different amounts and act upon the armature at different points said fluxes being so proportioned in value and phase that their joint action upon the armature will enable the meter to register the true energy consumed in an alternating-current circuit without being substantially affected by changes of phase relation.

10. In a watt meter for alternating currents, the combination of a field-magnet system having three intersecting magnetic axes, means for producing along one of said axes a magnetic flux proportional to the current and varying in phase therewith,
6 means for producing along another of said axes an alternating flux proportional to the electro-motive force and lagging behind the same and means for producing along the third axis an auxiliary magnetic flux also proportional to the electro-motive force, of such a magnitude and phase that the joint action of the several fluxes upon the armature will enable the meter to register the true energy consumed in an alternating-current circuit without being substantially effected by changes of phase relation.

11. In a meter for alternating currents, the combination of a field-magnet system having three intersecting magnetic axes, means for producing along one of said axes a magnetic flux proportional to the current and varying in phase therewith, means for producing along another of said axes an alternating flux proportional to the electro-motive force and lagging behind the same, and means for producing along the third axis an auxiliary magnetic flux also proportional to the electro-motive force and of such magnitude and phase that the joint action of the two potential fluxes upon the armature will produce a torque sufficient to overcome the static friction of the meter.

12. In a single-phase alternating-current meter, the combination of a field-magnet system having three intersecting magnetic axes, a field coil in which the current phase varies as the conditions of the circuit change, producing a magnetization along one magnetic axis, a potential coil producing a magnetization along another
7 magnetic axis, a reactance device in series with said potential coil for lagging the current behind the electro-motive force and a second potential coil depending for its current upon the first potential coil, producing a magnetization along the third magnetic axis; the two potential coils conveying currents which differ in phase from each other, and each generating a flux which acts upon the armature at a point removed from the point at which the flux due to the other potential coil acts upon the armature.

13. In an electric meter, the combination of a multipolar field-magnet structure having three magnetic axes, current coils mounted upon some of the field poles and producing a magnetization along one of said magnetic axes, potential coils mounted upon other field poles and producing a magnetization along another one of said

magnetic axes, and other potential coils mounted upon a portion only of the last-named field poles, or some of them, and producing a magnetization along the third magnetic axis and an armature acted upon by the flux induced by the field coils.

8. That on or about the 15th day of May, 1900, the primary examiner to whom, according to law, your petitioner's said application was referred by the Commissioner of Patents for examination, examined and considered said application and decided that your petitioner must cancel from said application his aforesaid claims numbered 7, 8, 9, 10, 11, 12 and 13, the same being all claims for the apparatus part of your petitioner's said invention and notified your petitioner of such decision.

8 9. That, after receiving the notice of said decision your petitioner persisted in his said claims in said application without altering his specification in any way and his said application was thereupon, by the primary examiner, reconsidered and his aforesaid claims numbered 7, 8, 9, 10, 11, 12 and 13 were, on or about the 31st day of July, 1900, a second time required to be cancelled from said application;

10. That on, or about the 4th day of August, 1900, your petitioner regarding the last-mentioned decision a second final rejection and refusal of his said claims Nos. 7, 8, 9, 10, 11, 12 and 13, by the primary examiner, and feeling aggrieved thereby, appealed therefrom, by written petition, to the board of examiners-in-chief, in accordance with the statute in such case made and provided and with the rules of practice in the United States Patent Office regulating such appeals, and paid to the Commissioner of Patents the statutory fee of \$10, required for such appeal.

11. That on or about the 9th day of August, 1900, the primary examiner, contrary to his duty, refused to answer said appeal and to forward the said appeal with his answer thereto and the statement required by the rules of practice in the United States Patent Office, to the said board of examiners-in-chief, and on or about the 16th day of August, 1900, upon your petitioner's request for a reconsideration of said action repeated his said last-mentioned decision and refusal;

12. That on or about the 20th day of August, 1900, your petitioner petitioned the Commissioner of Patents to direct the
9 said primary examiner to answer and forward said appeal, which petition was, on or about the 28th day of September, 1900, denied;

13. That thereafter, to wit, on or about the 16th day of January, 1902, your petitioner petitioned the present Commissioner of Patents, the said Frederick I. Allen, to direct the said primary examiner to answer said appeal, and to forward said appeal with his said answer thereto and with the statement required by the rules of practice of the U. S. Patent Office to the said board of examiners-in-chief for the determination of said board, which petition was on the 7th day of February, 1902, denied.

14. That your petitioner is advised and believes that the said de-

cision of the primary examiner of the 31st day of July, 1900, repeating his previous decision of the 15th day of May, 1900, requiring the cancellation from your petitioner's said application of all claims covering the apparatus part of his said invention, namely, his aforesaid claims 7, 8, 9, 10, 11, 12 and 13, constituted and constitutes, in fact and in law, an adverse decision upon the merits of your petitioner's aforesaid application and was and is a second rejection of the said claims 7, 8, 9, 10, 11, 12 and 13 of said application and that he is entitled, as a matter of right, under the statutes of the United States in such case made and provided, to an appeal from said adverse decision and second rejection of said claims by said primary examiner to the said board of examiners-in-chief and is entitled, as a matter of right, to have the validity of said adverse decision and second rejection revised and determined by the said board of
10 examiners-in-chief;

15. That, under the rules of practice of the United States Patent Office, it became and was the duty of the said primary examiner to, within five days of the filing of your petitioner's aforesaid appeal, answer such appeal by furnishing the board of examiners-in-chief with a written statement of the grounds of his decision on all the points involved in the appeal and to forward such answer and statement with such appeal, to the said board of examiners-in-chief, for the revision and determination by said board of such appeal;

16. That upon the refusal of the primary examiner to furnish such answer and statement and to forward the same to the said board of examiners-in-chief as aforesaid, it became and was the duty of the said Frederick I. Allen, Commissioner of Patents to direct the said primary examiner to furnish said answer and statement and forward the same with such appeal to the board of examiners-in-chief, and the failure and refusal of the said Frederick I. Allen, Commissioner of Patents, when so requested by your petitioner as aforesaid, to perform said duty and to make such direction rendered and renders it impossible for your petitioner to have the validity of the said second rejection and refusal by the said primary examiner of the aforesaid claims Nos. 7, 8, 9, 10, 11, 12 and 13, of his said application, revised and determined by the said board of examiners-in-chief, and in turn, if necessary, by the other duly constituted statutory tribunals of higher authority and operates to the great wrong and injury of your petitioner in the premises;

11 17. That, well hoping that the said board of examiners-in-chief might take jurisdiction of his said appeal and revise and determine the same, even without an answer or statement from the primary examiner in regard thereto and notwithstanding the action of the said Frederick I. Allen, Commissioner of Patents, aforesaid, your petitioner on the 28th day of February, 1902, petitioned the said board of examiners-in-chief, praying that said board of examiners-in-chief take jurisdiction of said appeal and revise and determine the same and reverse the aforesaid adverse decision of the said primary examiner but said petition was, on the 6th day of

March, 1902, denied by said board of examiners-in-chief on the ground that said board could not revise and determine said appeal without the said primary examiner's answer and statement, and further, in view of the decision of the said Frederick I. Allen, Commissioner of Patents, in the premises;

18. That by the refusal of the said Frederick I. Allen, Commissioner of Patents, to so direct the said primary examiner to furnish his said answer and statement and to forward the same with petitioner's said appeal to the board of examiners-in-chief, as requested, your petitioner was and is deprived of a legal right vested in him by the laws of the United States relating to the granting of letters patent for inventions and is entirely without redress or remedy in the premises, unless this honorable court by writ of mandamus shall interpose in his behalf.

12 Wherefore your petitioner prays that a writ of mandamus may be issued by this honorable court to the said Frederick I. Allen, Commissioner of Patents, commanding him to direct the primary examiner to forward your petitioner's said appeal to the board of examiners-in-chief with his proper answer and statement required by the rules of practice of the United States Patent Office, to the end that the aforesaid adverse decision of the primary examiner and the aforesaid second rejection of the said claims 7, 8, 9, 10, 11, 12 and 13, of your petitioner's said application by said primary examiner, complained of, may, by said board of examiners-in-chief, be revised and determined according to law, and that speedy justice may be done your petitioner in the premises. And as in duty bound your petitioner will ever pray, etc.

CHARLES P. STEINMETZ.

O K.

A. S. D.

CHURCH & CHURCH, Attorneys.
ALBERT G. DAVIS, Of Counsel.

STATE OF NEW YORK, }
County of Schenectady, } ss:

Charles P. Steinmetz, being duly sworn deposes and says, that he has read the foregoing petition by him signed and knows the contents thereof; that the statements therein contained are true of his own knowledge, except as to those matters therein stated to
13 be on information and belief and as to such matters he verily believes it to be true.

CHARLES P. STEINMETZ.

Subscribed and sworn to before me this 28th day of August, 1902.

BENJAMIN B. HULL,
[SEAL.] Notary Public, Schenectady County, N. Y.

Rule to Show Cause.

Filed September 9, 1902.

In the Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* CHARLES P. STEINMETZ, }
Petitioner,
vs.
FREDERICK I. ALLEN, Commissioner of Patents, } At Law. No. 45620.
Respondent.

Upon consideration of the petition for mandamus in the above-entitled cause, it is ordered, on this 9th day of September, 1902, that the respondent herein show cause, on the 17th day of September, 1902, at 10 o'clock a. m., before me at the special term of the court, why a writ of mandamus should not issue, as prayed in said petition; provided a copy of this order and of said petition be served upon the respondent on or before the 17th day of September, 1902.

JOB BARNARD,

*Associate Justice of the Supreme Court
of the District of Columbia.*

14

Return of Respondent.

Filed September 17, 1902.

In the Supreme Court of the District of Columbia.

THE UNITED STATES *ex Rel.* CHARLES P. STEIN- }
metz
vs.
FREDERICK I. ALLEN, Commissioner of Patents. } At Law. No. 45620.

To the honorable the justices of the supreme court of the District of Columbia:

The return of the respondent to the rule to show cause issued herein upon the 9th day of September, 1902.

The said Frederick I. Allen, Commissioner of Patents, comes and for answer to the order to show cause why the said writ of mandamus should not issue says, upon information and belief:

1. The respondent admits the allegations of the first paragraph of the petition.
2. The respondent admits the allegations of the second paragraph of the petition.
3. As to the third paragraph of the petition, the respondent denies that the application was in due form as required by the statutes

and rules of practice, since it included claims to an apparatus and claims to a process. The respondent admits that in other respects the application was in proper form.

4. The respondent admits the allegations of the fourth paragraph of the petition.
- 15 5. The respondent admits the allegations of the fifth paragraph of the petition.
6. As to the sixth paragraph of the petition, the respondent denies that the application fully complied with the statutes and rules of practice, since it included claims to an apparatus and claims to a process.

7. The respondent admits the allegations of the seventh paragraph of the petition.

8. As to the eighth paragraph of the petition, the respondent admits that the examiner having charge of the relator's application wrote a letter to him on May 15, 1900, saying:

"In accordance with office letter of January 2, 1900, applicant is required to cancel from this case all claims except those for the method."

In further explanation of this matter, the respondent says that prior to May 15, 1900, and on October 9, 1899, the primary examiner wrote a letter to the relator, requiring division between the process claims and the apparatus claims, in accordance with rule 41, before further action would be given upon the merits of the case. In a reply filed December 15, 1899, the respondent asked that his process claims be placed in interference with the claims of a patent granted to one Duncan, and said:

"It is therefore requested that the retirement for division be waived for the present in order that an interference with the patent to Duncan above referred to may be declared."

The examiner then wrote a letter on January 2, 1900, saying:

16 "Pending the determination of the interference applicant may retain the method and apparatus claims in this case, but the acceptance of an interference on one of the method claims will be held by the office to be an election of the prosecution of the method claims, and further prosecution of the apparatus claims in this application will not be permitted."

The relator's reply, filed January 19, 1900, was:

"It is respectfully requested that the interference with the Duncan patent, No. 604,464, be declared as soon as possible."

The interference was thereupon declared on February 7, 1900, and the decision therein was in favor of the relator and against Duncan. After that decision the examiner wrote the said letter of May 15, 1900.

By his request for the interference in reply to the examiner's warning as to the effect of such request, the relator eliminated from consideration the question which of the two inventions claimed would be retained in this case if division was finally insisted upon, and he is estopped from denying that the apparatus, if either, must

be presented in a separate application. His action in accepting the ruling of the office upon the question of election, and thereby obtaining the interference, left open for final decision only the question whether division should be required, and it was upon this question that the examiner ruled in his letter of May 15, 1900.

9. As to the ninth paragraph of the petition, it is admitted that the relator filed a letter on July 16, 1900, asking for a reconsideration of the examiner's action, and that the examiner thereupon repeated his action.

17 10. The respondent admits that the relator filed an appeal and paid the fee, but denies that the statute and rules of practice provide for such appeal, as alleged in the tenth paragraph of the petition herein.

11. The respondent admits that the primary examiner refused to answer and forward the appeal, as alleged in the eleventh paragraph of the petition.

12. The respondent admits the allegations of the twelfth paragraph of the petition; a copy of the decision denying the petition is hereto attached, as Exhibit A.

13. The respondent admits the allegations of the thirteenth paragraph of the petition and attaches hereto and as a part hereof a copy of his decision dated February 7, 1902, marked Exhibit B.

The respondent further alleges that before the date of the said petition and decision, the relator had under the provision of rule 145 petitioned the respondent as Commissioner of Patents to review and reverse the action of the primary examiner requiring division, and after a full consideration of the matter the respondent was of the opinion that the requirement for division was proper and for that reason denied the petition on January 2, 1902.

14. The respondent denies that the examiner's letter of July 31, 1900, was a second rejection of claims made by the relator, and denies that the relator has the right of appeal therefrom to the examiners-in-chief. The examiner's action was merely a ruling that the relator should present in two applications, in accordance with the provisions of rule 41, approved by the Secretary of the Interior, the two inventions now claimed in one application, and did not involve the rejection of any claim or an action upon the merits of any claim made by the relator. The statutes and

18 rule 133 of the rules of practice do not provide for an appeal to the examiners-in-chief from an examiner's requirement for division, and the examiners-in-chief have no jurisdiction to pass upon the question whether or not division should be required.

15. The respondent denies that it was the duty of the primary examiner to forward the appeal and to furnish a statement of the grounds of his action, as alleged in the fifteenth paragraph of the petition herein.

16. The respondent denies that it was his duty to direct the primary examiner to forward the appeal, for the reason that no authorized appeal had been filed, as alleged in the sixteenth paragraph of the petition herein.

17. The respondent admits the allegations of the seventeenth paragraph of the petition.

18. The respondent denies that the relator has by the action of the respondent been deprived of any legal right vested in him by the laws of the United States, as alleged in the eighteenth paragraph of the petition herein.

The respondent further says that by reason of the facts hereinbefore alleged, he should be dismissed with his reasonable costs.

FREDERICK I. ALLEN.

JOHN M. COIT, *Attorney.*

19 DISTRICT OF COLUMBIA, *ss:*

On this day personally appeared before me, a notary public in and for the said District of Columbia, Frederick I. Allen, and made oath that he is the respondent in the above-entitled cause; that he has read the foregoing answer by him subscribed and knows the contents thereof; that the same is true of his own knowledge, except as to the matters therein stated to be alleged on information and belief, and that as to those matters he believes it to be true.

FREDERICK I. ALLEN.

Given under my hand this 16th day of September, 1902.

A. M. BUNN,
[SEAL.] *Notary Public for the District of Columbia.*

20

EXHIBIT A.

Filed September 17, 1902.

Where applicant does not care to comply with the examiner's requirements in a matter of division such as is here involved, it has been the practice for the past thirty years to treat the question not as one of merits and appealable to the examiners-in-chief, but as a proper matter for petition to the Commissioner. I see no reason for overturning this practice. The petition is denied.

WALTER H. CHAMBERLIN,
Assistant Commissioner.

September 28, 1900.

21

EXHIBIT B.

Filed September 17, 1902.

Jan. 22, 1902.

M. H.

United States Patent Office.

Ex Parte CHARLES P. STEINMETZ.

Motor meters.

Petition.

Application filed November 21, 1896; No. 612,943.

Mr. Albert G. Davis for applicant.

This is a petition from the action of the primary examiner refusing to forward to the examiners-in-chief an appeal in the above-entitled case.

The examiner required division in this application between claims to the apparatus and claims to the process, and this action was clearly correct under the express provisions of rule 41. The applicant then asked for an interference with a patent containing the process claims, and that interference was declared, the applicant being informed that the request for an interference upon the process was considered an election to retain the process claims in this case, and that after the conclusion of the interference he would be required to cancel from the case the apparatus claims. The interference was decided in favor of this applicant and the examiner then insisted upon his requirement that the application be divided and that the apparatus claims be canceled. The petitioner states that this action amounted to a refusal of the apparatus claims, and

22 therefore took an appeal to the examiners-in-chief. The examiner refused to forward the appeal, upon the ground that the questions involved are petitionable to the Commissioner and are not appealable to the examiners-in-chief.

The requirement for division is clearly a matter of form, not involving the merits of the claims, since the claims may be, and in the present case are, regarded as allowable. The examiner has not refused to grant a patent to this applicant upon any of the claims presented, but has merely required that they be included in two patents instead of one. It is a question of procedure or of the manner of securing the protection which is in controversy and not the right of the applicant to a patent upon any of the claims presented.

The examiner was right in taking the position that the question involved is not appealable to the examiners-in-chief, and although it is a general rule of law that the appellate tribunal is the one to

determine whether or not it has jurisdiction when an appeal is taken to it, it is not considered necessary in the office practice to follow that practice strictly, since the Commissioner is the head of the office and has the final decision upon all questions arising within it and may settle questions of this kind upon direct petition. The examiner's decision upon the question whether or not an appeal to the examiners-in-chief is regular and proper is not final, since it may be reviewed by the Commissioner upon petition, but he has authority to pass upon that question in the first instance.

The petition is denied.

F. I. ALLEN,
Commissioner.

February 7, 1902.

23

Motion for Judgment, &c.

Filed September 25, 1902.

In the Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* CHARLES P. STEIN-
metz }
vs. } At Law. No. 45620.
FREDERICK I. ALLEN, Commissioner of Pat-
ents. }

And now comes the relator, by Church & Church, his attorneys, and moves the court for judgment for a peremptory writ of mandamus against the respondent, notwithstanding the return of the respondent herein.

CHURCH & CHURCH,
Attorneys for Relator.

24

Opinion of the Court.

Filed December 2, 1902.

In the Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* CHARLES P. STEINMETZ }
vs. } No. 45620. Law.
FREDERICK I. ALLEN, Commissioner of Patents. }

This proceeding is instituted for the purpose of obtaining a mandamus against the Commissioner of Patents to require him to direct the primary examiner to forward to the board of examiners-in-chief an appeal which the relator has asked in a matter pending in the Patent Office, wherein he has applied for a patent for certain new and useful improvements in motor meters.

In his said application, being serial No. 612,943, thirteen claims are stated in separate paragraphs. The primary examiner decided that the seven claims numbered 7 to 13 should be cancelled, or stricken from the application, and only the six claims first named should be considered. This ruling is based upon the contention of the examiner that the said several groups of claims are not properly related to each other, or to the alleged invention, so as to entitle them to be covered by a single patent, if one should be allowed ; and for that reason, it is held that only one group should be considered in a single application ; and that if the other group is to be considered at all, it must be in a separate application, thus making two cases instead of one. The relator contends that all the claims
are properly united in a single application, and should be
25 so considered ; and if patentable, that a single patent should
be issued covering all of them ; and that it would be unlaw-
ful to grant two patents for a single invention ; and if granted, the
last one would be invalid.

From this ruling of the primary examiner requiring the cancellation of the seven claims last stated in the application, which it is contended has been twice made, the relator asked an appeal to the board of examiners-in-chief ; but the same was denied. He then applied to the Commissioner to direct such appeal, but was answered, that the requirement for division was clearly a matter for form, not involving the merits of the claims ; and that in such a matter, no appeal to the examiners-in-chief would lie.

He then applied to the board of examiners-in-chief to hear said appeal, but they declined to hear the same, because the primary examiner had not forwarded the necessary papers, and because the Commissioner had refused, on petition, to require such appeal to be forwarded to them by the said primary examiner.

The application is therefore made to this court for a mandamus in the premises, on the theory that the petitioner has a statutory right to such appeal ; and that there is no discretion in the Commissioner to refuse it.

The claims, which the examiner required should be divided, were alleged, to be claims pertaining to the apparatus, and claims pertaining to the process, and the power to require such division is said to be conferred by rule 41 of the Patent Office rules. That rule provides that "claims for a machine, and the process in the performance of which the machine is used, must be presented in separate applications." Rule 42 provides, that "if several inventions, claimed in a single application, be of such a nature that a
26 single patent may not be issued to cover them," the inventor will be required to elect as to which he will prosecute ; and the others may be made the subjects of separate applications.

The Commissioner of Patents is authorized to establish regulations, not inconsistent with law, and subject to the approval of the Secretary of the Interior, "for the conduct of proceedings in the Patent Office." Sec. 483, R. S. U. S.

Section 4909 R. S. U. S. provides that every applicant for a patent,

"any of the claims of which have been twice rejected," may have his appeal from the primary examiner to the board of examiners-in-chief.

For the conduct of proceedings in appeal under this statute, the Commissioner has adopted certain regulations, appearing in rules number 133 and 134. By these it is provided, that every applicant for a patent any of whose claims "have been twice rejected *for the same reasons, upon grounds involving the merits of the invention,* * * *" may, upon payment of a fee of \$10 appeal from the decision of the primary examiner," &c. and "all the claims must have been passed upon and all preliminary and intermediate questions relating to matters not affecting the merits of the invention settled, before the case can be appealed," &c.

Are these regulations consistent with law, and do they reasonably and fairly pertain to the conduct of proceedings in the Patent Office? If so, the mandamus prayed for in this case should be denied; but if not, and the relator shows himself entitled to his appeal
27 under the statute, and has no other remedy in the premises, then the mandamus ought to be granted.

In a case clearly involving two separate inventions, it would seem proper that the claims referring to each should be divided and presented in two applications instead of in one; and that such requirement is properly a matter of practice or procedure, to be regulated by the Commissioner in the interest of all parties having business with the office. The hardship, if any, would appear to be in those cases where there may be doubt as to the claims describing two inventions. So that the applicant may not suffer an injustice in such preliminary matter, in case the primary examiner decides against him, the Commissioner has adopted rule 145, which provides for an appeal directly to the Commissioner, by petition, without fee.

It is contended by counsel for petitioner, that the statute contemplates an appeal in such formal, or preliminary matter, to the board of examiners-in-chief, and thence to the Commissioner, and finally to the Court of Appeals of the District of Columbia, the same as if the patentability of the claims was in question, rather than the manner of their presentation to the office.

In this case the examination as to the alleged new invention or discovery, required by sec. 4893 R. S. U. S., has not been made, and the questions as to its novelty, usefulness or importance, or the right of the applicant to have a patent, have not been decided; and therefore it is contended that the claims have not been rejected, within the meaning of said section 4909 granting the right of appeal.

What the relator alleges to be error, and for which he desires the appeal, is only a matter of practice or procedure, the very
28 thing that the Commissioner is empowered to regulate by established rules. It is a question of pleading, or of description of alleged invention, and in no way involves the novelty, or usefulness of the same, and therefore deprives the applicant of no substantial right, *provided* the claims ordered cancelled can be properly considered in a separate application.

It is urged by counsel for the relator that if the invention described in the several paragraphs of the application, is in fact one, then the requirement that the several claims constituting the proper description of it shall be divided, and two applications filed for the one invention, will be a denial, of justice, because the grant of a patent for one part of a unit would preclude the grant of a patent for the second part; or, if granted, the second patent would be invalid.

Although the compulsory division of claims pertaining to a single invention may be a serious matter for the inventor, it is still interlocutory, and it does not seem to be one that can be remedied by a proceeding in mandamus, for it is a technical question peculiarly within the jurisdiction of the Commissioner of Patents, and requires judgment on his part to decide. If wrong in his conclusion, he cannot be set right by mandamus. The decisions on such interlocutory questions of practice, are seldom appealable under any of the judicial systems of our country. If appeals were intended, in the executive departments of the Governments, from rulings involving only the method of doing things, or the form in which claims should be stated, or other preliminary or interlocutory orders or decisions, they should be provided for expressly, and not left to be

29 raised by implication.

As to whether the primary examiner has committed an error in this matter, or whether the relator is correct in his contention that all his claims are properly united in one application, is not important in this proceeding, and hence no opinion is expressed on that question. The question presented here is as to the right of appeal, not as to the merits of the decisions to be appealed from. The result to the claimant of an erroneous judgment by the primary examiner in requiring a division of the claims in an application, is not necessarily the loss of his right to a patent. In most cases perhaps it is only an increase of the cost of obtaining the patent; and the question of costs is one that is seldom considered on an appeal.

In my opinion the statute authorizing an appeal, when claims have been twice rejected, means that the claims must have been considered on their merits, and found to be not patentable; and therefore that nothing inconsistent with this law is found in rules 133 and 134, regulating the procedure in appeals, so far as the same relates to a case like this.

That a decision on the merits must first be had before an appeal can be taken to the board of examiners-in-chief would seem to be as necessary as it would be to the right of the applicant to file a bill in equity under sec. 4915 R. S. U. S., and the Supreme Court holds it to be indispensable in that case. *Butterworth v. U. S. ex rel. Hoe*, 112 U. S. 50.

For these reasons, and without further considering the question of the discretion of the Commissioner, or the question of estoppel argued in this case, I think the relator has not shown himself entitled to the appeal prayed for under the law, and that the writ of mandamus must be denied.

JOB BARNARD, *Justice.*

Final Judgment.

Filed December 19, 1902.

In the Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* CHARLES P. STEINMETZ }
vs. }
FREDERICK I. ALLEN, Commissioner of Pat- } At Law. No. 45620.
ents. }

This cause coming on to be heard upon the relator's petition for a writ of mandamus against the respondent, the rule to show cause, the return and the motion of the relator for a peremptory writ of mandamus notwithstanding the return, and having been argued by counsel for the respective parties and considered by the court, it is by the court this 19th day of December, 1902, ordered and adjudged that the rule to show cause is hereby discharged and that the relator's petition be, and the same is hereby, dismissed at the costs of the relator. The relator having prayed an appeal to the Court of Appeals of the District of Columbia from the judgment of this court dismissing his petition, such appeal is hereby allowed, and
31 the bond is fixed in the penalty of two hundred and fifty dollars.

JOB BARNARD, *Justice.*

Approved as to form:

JOHN M. COIT,
*Attorney for Respondent.**Memorandum.*

December 19, 1902.—Appeal bond filed.

32 Supreme Court of the District of Columbia.

UNITED STATES OF AMERICA, } ss:
District of Columbia, }

I, John R. Young, clerk of the supreme court of the District of Columbia, hereby certify the foregoing pages, numbered from 1 to 31, inclusive, to be a true and correct transcript of the record, as per rule 5 of the Court of Appeals of the District of Columbia, in cause No. 45,620, at law, wherein The United States *ex rel.* Charles P. Steinmetz is petitioner, and Frederick I. Allen, Commissioner of Patents, is respondent, as the same remains upon the files and of record in said court.

Seal Supreme Court
of the District of
Columbia.

In testimony whereof, I hereunto subscribe
my name and affix the seal of said court, at
the city of Washington, in said District, this
9th day of January, A. D. 1903.

JOHN R. YOUNG, Clerk.

Endorsed on cover: District of Columbia supreme court. No. 1272. United States *ex relatione* Charles P. Steinmetz, appellant, vs. Frederick I. Allen, Commissioner of Patents. Court of Appeals, District of Columbia. Filed Jan. 13, 1903. Robert Willett, clerk.

